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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,698	12/21/2001	Ilikka Rahnasto	367.39588X00	6934
22907	7590	11/16/2006	EXAMINER	
BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001				BAYAT, BRADLEY B
ART UNIT		PAPER NUMBER		
		3621		

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/023,698	RAHNASTO, ILKKA	
	Examiner Bradley B. Bayat	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 August 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 33-38, 41, 46-50, 52, 54, 56 and 57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 33-38, 41, 46, 47-50, 52, 54, 56 and 57 is/are rejected.
- 7) Claim(s) 36, 37 and 52 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 25, 2006 has been entered.

### ***Status of Claims***

This communication is in response to amendment filed on August 25, 2006. Claims 33, 34, 36, 46 and 56 have been amended. Thus claims 33-38,41,46-50,52,54,56 and 57 remain pending.

### ***Response to Arguments***

Applicant's arguments filed 8/25/2006 are moot in view of the following new ground(s) of rejection.

### ***Claim Objections/ Optional Elements***

Claims 36, 37 and 52 objected to because of the following informalities: applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: “Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]”; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) (“As a matter of linguistic precision, optional elements

do not narrow the claim because they can always be omitted.”). In the instant case, applicant utilizes “operable to...” language.

Appropriate correction is required.

***Functional Language/112 2<sup>nd</sup> paragraph Alternative Rejection***

Claim 33 recites a network device followed by language describing the intended use and functional of the claimed device. A mere statement of intended use is entitled to “no patentable weight” since the body of the claim completely defines the structure of the claimed invention; *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (noting that “Schreiber's contention that his structure will be used to dispense popcorn does not have patentable weight if the structure is already known, regardless of whether it has ever been used in any way in connection with popcorn.”); *In re Hutchison*, 154 F.2d 135, 69 USPQ 138, 141 (CCPA 1946) (noting that the recitation that an element is “adapted” is not a positive limitation but only requires the ability to perform. It “does not constitute a limitation in any patentable sense.”); and *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)(“A whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited. [Emphasis added.]”). As such, the language of claim 33 describing the functionality of the claimed device fails to impart patentable weight and the examiner need not provide supporting art beyond a network device comprising a controller.

However, since the amendment to the claim and applicant’s remarks recite “along a communication path,” the claim is alternatively indefinite. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 33 is otherwise rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Since applicant has claimed a device, the mere adaptability to connect to another elements outside the scope of the claim (a communication path) does not make the claim a combination claim. See *In re Dean*, 130 USPQ 107 (CCPA 1962).

The examiner respectfully requests the applicant to fully address the rejections recited in the alternative above.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 33-38,41,46-50,52,54,56 and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Shippy et al., (hereinafter Shippy, US 2005/0254645 A1).**

As per the following claims, Shippy discloses:

33. A network device for connection in a communication path of a network comprising a controller operable to detect, along a communication path, a predetermined tag within content

passed along the communication path and to report the detection together with information identifying a sender and/or recipient of the content [0055-66, payload contains tag identifying the stream source].

34. A method of monitoring content transmitted by a network comprising detecting along the communication path a predetermined tag within content transmitted through the network and reporting the detection together with information identifying a sender and/or recipient of the content with a network device [0055-66, payload contains tag identifying the stream source].

35. A computer program product stored in a computer readable medium for carrying out the method according to claim 34 in a processor in the network which when executing causes the processor to perform the steps of: detecting a predetermined tag within the content by the network; and responding the detection together with information identifying at least one of a sender of the content and a recipient of the content [0055-66, payload contains tag identifying the stream source; 0033-0034, computer program].

36. A system for monitoring transmission of content between terminals in a network comprising a network device located in a communication path in the network and a monitoring center connected to the device wherein a controller is included in the device which is operable to detect along the communication path a predetermined tag within content in the communication path and to report the detection of the predetermined tag together with information identifying a sender and/or recipient of the content to the center [0055-66; fig 10-12 and associated text].

37. A system as claimed in Claim 36, wherein the monitoring center is operable to receive reports from a plurality of networks each having at least one controller [0033-38].
38. A system as claimed in Claim 36, comprising a billing entity connected to the center [0055; negotiation and authentication engine for access].
41. A system as claimed in Claim 34, wherein the information includes a network identity such that the center issues the request to a billing entity responsible for the identified network [0055, stream identifier; figs 14-17 and associated text].
46. A method of transmitting a message incorporating content including an embedded tag from a terminal connected to a network using a network device along the communication path the method comprising, obtaining content, placing the content and tag into a payload portion of the message, and transmitting the message over the network including the device [0055-66, tag payload content data].
47. A method as claimed in Claim 46, wherein the content is obtained by downloading from a server [0059-60, decrypting data stream on a communication network].
48. A method as claimed in Claim 46, wherein the content is obtained from a data carrier uploading from a player of the data carrier [fig 4 and associated text].

49. A method as claimed in Claim 46, wherein the message comprises at least one packet [0055].

50. A method as claimed in claim 49, wherein the tag is embedded in the at least one packet [0055].

52. A computer program which performs the method of claim 34 stored in a computer readable medium comprising executable code for execution when loaded on a controller within the network, wherein the controller is operable in accordance with the code [0060-61; fig 14 and associated text].

54. A computer program which performs the method of claim 46 stored in a computer readable medium comprising executable code for execution when loaded on a controller within the network, wherein the controller is operable in accordance with the code [0056; fig 14 and associated text].

56. A method of generating a control message by a network device along the communication path to be sent to a monitoring center connected to the device, the control message indicating passing of content having a predetermined tag embedded within the content through the network device, the control message comprising an identification of the content originating device, a destination address for the content, and a flag created by the network device [0055-66].

57. A method as claimed in Claim 56, wherein the flag identifies the network device [0055-66].

*Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.*

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday-Friday 8 a.m.-6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Bradley B. Bayat  
Patent Examiner  
Art Unit 3621